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REMARKS

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of the presented claims are in condition for allowance.

I. REJECTION OF CLAIMS 1-9, 11-17 and 22-34 UNDER 35 U.S.C. § 102**A. Claims 1-5, 8, 15-17 and 22-24**

The Examiner rejected claims 1-5, 8, 15-17 and 22-24 as being anticipated under 35 U.S.C. §102(e) by the Solomon application (United States Patent Application Publication No. 2002/0046157, published April 18, 2002, hereinafter "Solomon"). In response, the Applicants have amended independent claims 1 and 15, from which claims 3-5, 16-17 and 22-24 depend, as well as independent claim 8, in order to more clearly recite aspects of the present invention. Claim 2 has been cancelled without prejudice.

Primarily, the Applicants respectfully submit that the Examiner's use of Solomon as prior art against Applicants' invention is improper. Solomon was filed on December 3, 2001. The present application was filed on March 29, 2001. Since the filing date of the present application precedes the filing date of Solomon, Solomon is not prior art to Applicants' invention.

The Applicants note that Solomon claims priority to two provisional patent applications filed individually on November 1, 1999 and December 1, 2000 (hereinafter referred to as "Solomon provisional application I" and "Solomon provisional application II", respectively). Under 35 U.S.C. §102(e), the filing date of a provisional patent application may be the effective filing date of a United States patent claiming priority to such provisional patent application only to the extent that such provisional patent application supports the subject matter used to make the rejection. See MPEP §706.02(f). Thus, the Examiner must provide some evidence that Solomon provisional application I and/or Solomon provisional application II supports the subject matter of the published Solomon application used in the rejection. Specifically the Applicants

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question whether Solomon provisional application I and/or Solomon provisional application II contains the subject matter used by the Examiner in the rejection.

Notably, there is no prohibition against the inclusion of subject matter in a non-provisional patent application that was not described in a prior provisional application to which the non-provisional application claims priority. That is, a non-provisional patent application may include new material not described in the provisional application. It is axiomatic that such new material does not receive the benefit of the provisional application. Applicants are not aware of any law or rule that states that all subject matter described in a non-provisional application is presumed to be described in a provisional application to which the non-provisional application claims priority. Thus, it is possible that the subject matter in the published Solomon application relied on by the Examiner is not described in the Solomon provisional applications. That is, the subject matter in the published Solomon application relied on by the Examiner may constitute new material with respect to Solomon provisional application I and Solomon provisional application II. In such a case, the cited subject matter would not constitute prior art to Applicants' invention.

Therefore, in order to set forth a prima facie case, the Examiner must provide evidence that Solomon provisional application I and/or Solomon provisional application II supports the subject matter of the published Solomon application used by the Examiner in the rejection. As such, without such evidence, the Applicants respectfully request the rejection to independent claims 1, 3-5, 8, 15-17 and 22-24 over Solomon be withdrawn.

Moreover, even assuming that the rejection under 35 U.S.C. §102(e) in light of Solomon is appropriate, the Examiner's attention is respectfully directed to the fact that Solomon fails to teach or suggest the novel invention of forming a negotiation meta contract to control a contract negotiation, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document.

By contrast, the portions of Solomon that the Examiner cites to support the teaching of using an electronic document to form a negotiation meta contract at most teach the use of codes to transfer information. The Examiner equates these codes with the electronic documents claimed by the Applicants ("the codes used to perform

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negotiations are considered electronic documents", Page 3 of the Final Office Action). The Applicants respectfully disagree with this characterization of Solomon's teachings. Specifically, the discussion of codes by Solomon is very cursory, offering several figures with little explanation as to their content (see, e.g., paragraph 0408 of Solomon, which briefly discusses FIGS. 87 through 91). It is not entirely clear from the discussion provided by Solomon what the nature of the codes is. Moreover, it is not clear how these codes are used; at best, Solomon describes that the codes are used to facilitate information exchange (see, e.g., Solomon at paragraph 0028: "the system uses codes to transfer information"; and at paragraph 0408: "Most agent interaction involves the exchange of information using these codes"). Nowhere, however, does Solomon teach that the codes are used to form a negotiation meta contract to control a contract negotiation. Thus, even assuming, *in arguendo*, that the codes could be equated with electronic documents, it does not appear that Solomon uses these codes in the same way that the claimed invention uses the recited electronic documents, as recited by Applicants' amended claims 1, 8 and 15. Specifically, Applicants' claims 1, 8 and 15, as amended, positively recite:

1. A method for automating contract negotiation between a plurality of parties, each of the plurality of parties having at least one computing system coupled to a communications network and one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the contract negotiation;

forming a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation;

communicating a request to negotiate; and

conducting an automatic negotiation, according to the negotiation meta contract, between the one or more applications of each of the plurality of parties. (Emphasis added)

8. A method for conducting a negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, the method comprising the steps of:

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providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation; and

providing a starting state for a contract in accordance with the specification, wherein the starting state, the starting state formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation, the at least one electronic document being selectable from one of: a previous contract, a publicly defined template, and a template defined prior to the negotiation by one of the parties. (Emphasis added)

15. A method for conducting a negotiation between a plurality of parties, each of said parties having a server coupled to a communication network and one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation;

enabling an automatic negotiation to take place between the servers in accordance with the specification of machine-executable rules; and

forming a meta contract for controlling a negotiation process in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation. (Emphasis added)

Since Solomon does not teach or suggest forming a negotiation meta contract to control a contract negotiation, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, Solomon does not teach each and every element of Applicants' amended independent claims 1, 8 and 15. Moreover, dependent claims 3-5, 16-17 and 22-24 depend, either directly or indirectly, from independent claims 1, 8 and 15 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 3-5, 16-17 and 22-24 are also not anticipated and are allowable.

Therefore, Applicants contend that claims 1, 3-5, 8, 15-17 and 22-24 are patentable over Solomon and, as such, fully satisfy the requirements of 35 U.S.C. §102. Thus, Applicants respectfully request that the rejection of claims 1, 3-5, 8, 15-17 and 22-24 under 35 U.S.C. §102 be withdrawn.

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B. Claims 1, 6-9, 11-17, 23 and 25-34

The Examiner rejected claims 1, 6-9, 11-17, 23 and 25-34 as being anticipated under 35 U.S.C. §102(e) by the Batachia et al. patent (United States Patent No. 7,103,580, issued September 5, 2006, hereinafter "Batachia"). In response, the Applicants have amended independent claims 1, 8, 12, 15, 28 and 31 from which claims 6-7, 9, 11, 13-14, 16-17, 23, 25-27, 29 and 32 depend, as well as independent claims 30, 33 and 34, in order to more clearly recite aspects of the present invention.

The Examiner's attention is respectfully directed to the fact that Batachia fails to teach or suggest the novel invention of forming a negotiation meta contract to control a contract negotiation, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, as recited in Applicants' amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34. Applicants' independent claims 1, 8 and 15 have been recited above. Applicants' claims 12, 28, 30, 31, 33 and 34 positively recite:

12. A method for conducting an automatic negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the negotiation;

creating a template prior to the negotiation in accordance with the negotiation protocol, wherein the template is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation, wherein the template contains business logic for performing a negotiation electronically;

registering the business logic, prior to the negotiation, with a server accessible by one or more parties; and

implementing the business logic in a negotiation conducted automatically between computer systems over the communication network. (Emphasis added)

28. A method for conducting a negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed

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upon by the plurality of parties prior to conducting the negotiation;
forming a meta contract to control the negotiation, in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation; and
enabling an automatic negotiation to take place between the parties in accordance with the specification of machine-executable rules;
wherein at least one of the negotiating parties is an intermediary for facilitating the automatic negotiation. (Emphasis added)

30. A computer program product in a computer readable medium in a first computer system for conducting a negotiation between a plurality of parties, comprising:

first instructions for providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation, wherein the specification is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation;

second instructions for enabling an automatic negotiation to take place between a party located at the first computer system and a party located at a second computer system in accordance with the specification of machine-executable rules; and

third instructions for negotiating a contract automatically between the parties. (Emphasis added)

31. A method of conducting a negotiation over a data communication network between a service provider and a service requester, comprising the steps of:

establishing, by the service provider and the service requester, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the service provider and the service requester prior to the contract negotiation;

providing, by the service provider, a negotiation meta-contract to control the negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one of the service provider and the service requester in at least one electronic document, prior to the negotiation;

receiving, at the service provider, a request to negotiate from the service requester;

responsive to the request to negotiate, automatically negotiating with the service requester by the service provider in accordance with the negotiation meta-contract. (Emphasis added)

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33. A method of conducting business over the Internet, wherein parties negotiate contractual terms between two data communication network components, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for generating at least one contract, the specification being agreed upon by the parties prior to negotiating the contractual terms;

forming a meta contract to control the negotiating, in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation; and

originating a negotiation at a first party in accordance with the rules of negotiation. (Emphasis added)

34. An article of manufacture for automating contract negotiation between a plurality of parties, comprising a machine readable medium containing one or more programs which when executed implement the steps of:

communicating, in a preliminary step, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the contract negotiation;

communicating a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation;

communicating a request to negotiate; and

conducting an automatic negotiation, according to the negotiation protocol, between the one or more applications of each of the plurality of parties. (Emphasis added)

Since Batachia does not teach or suggest forming a negotiation meta contract to control a contract negotiation, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, Batachia does not teach each and every element of Applicants' amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34. Moreover, dependent claims 6-7, 9, 11, 13-14, 16-17, 23, 25-27, 29 and 32 depend, either directly or indirectly, from independent claims 1, 8, 12, 15, 28 and 31 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 6-7, 9, 11, 13-14, 16-17, 23, 25-27, 29 and 32 are also not anticipated and are allowable.

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Therefore, Applicants contend that claims 1, 6-9, 11-17, 23 and 25-34 are patentable over Batachia and, as such, fully satisfy the requirements of 35 U.S.C. §102. Thus, Applicants respectfully request that the rejection of claims 1, 6-9, 11-17, 23 and 25-34 under 35 U.S.C. §102 be withdrawn.

II. REJECTION OF CLAIMS 10 AND 18-21 UNDER 35 U.S.C. § 103

A. Claim 10

The Examiner rejected claim 10 as being unpatentable under 35 U.S.C. §103(a) over Solomon in view of the Brothers patent (United States Patent No. 7,035,817, issued April 25, 2006, hereinafter "Brothers"). In response, the Applicants have amended independent claim 8, from which claim 10 depends, as discussed above in order to more clearly recite aspects of the present invention.

As discussed above, Solomon fails to teach or suggest the novel invention of forming a negotiation meta contract to control a contract negotiation, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, as recited in Applicants' amended independent claim 8. Brothers fails to bridge this gap in the teachings of Solomon. Thus, Solomon in view of Brothers does not teach each and every element of Applicants' claim 8. Moreover, dependent claim 10 depends from independent claim 8 and recites additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claim 10 is also not made obvious and is allowable.

Therefore, Applicants contend that claim 10 is patentable over Solomon in view of Brothers and, as such, fully satisfies the requirements of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claim 10 under 35 U.S.C. §103 be withdrawn.

B. Claims 18-21

The Examiner rejected claims 18-21 as being unpatentable under 35 U.S.C. §103(a) over Batachia in view of the Su et al. article ("A Replicable Web-Based Negotiation Server For E-Commerce", hereinafter "Su"). In response, the Applicants

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have amended independent claim 15, from which claims 18-21 depend, as discussed above in order to more clearly recite aspects of the present invention.

As discussed above, Batachia fails to teach or suggest the novel invention of forming a negotiation meta contract to control a contract negotiation, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, as recited in Applicants' amended independent claim 15. Su fails to bridge this gap in the teachings of Batachia. Thus, Batachia in view of Su does not teach each and every element of Applicants' claim 15. Moreover, dependent claims 18-21 depend, either directly or indirectly, from independent claim 15 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 18-21 are also not made obvious and are allowable.

Therefore, Applicants contend that claims 18-21 are patentable over Batachia in view of Su and, as such, fully satisfy the requirements of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claims 18-21 and 25-34 under 35 U.S.C. §103 be withdrawn.

III. CONCLUSION

Thus, the Applicants submit that all of the presented claims fully satisfy the requirements of 35 U.S.C. §102 and 35 U.S.C. §103. Consequently, the Applicants believe that all of these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the maintenance of the final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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